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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,448	12/18/2000	Jerome Dale Johnson	7709.159US1	3475

22854 7590 12/14/2004

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EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,448

Applicant(s)

JOHNSON ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 11-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 25 August 2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 18 December 2000. Claims 1-19 are pending.

Claim Objections

2. Claims 11-14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 11-14 recite "[a] computer-readable medium having computer-executable instructions" for the methods of the claims on which they depend and "[a] computer data signal embodied in a carrier wave readable by a computing system and encoding a computer program of instructions for executing a computer process performing" the methods on which they depend. These claims do not pass the "Infringement Test" for dependent claims. See MPEP § 608.01 (n).

Claim Rejections - 35 USC §101

3. Claims 1-10, 13-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-10, 13-14 only recite abstract ideas. The recited steps of merely collecting and storing customer data, presenting options, selecting insurance plans and generating a customized proposal do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute different parts of a method for providing information to assist a customer in selection of insurance plans.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. Regarding the body of the claims, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an

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otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In this regard the Examiner notes that although claim 1 recites a sales computer system and storing customer data within a database on the sales computer system, which are included in the technological arts, the computer usage is interpreted as merely storing data which is to be read or outputted by a computer without any functional interrelationship, and thus does not impart functionality to the computer, rendering it an example of non-functional descriptive material *per se*; furthermore, the remainder of the claim limitations of claims 1-10, 13-14 fail to apply, involve, use, or advance the technological arts.

Furthermore, as regards the recitation in claims 13 and 14 of a “computer data signal,” signals *per se* are not statutory subject matter. If the signal claim is interpreted as an abstract arrangement “to be transmitted”, or as a transmission in transit, the signal claim is considered non-statutory, whereas the combination of signals with statutory physical structure may be statutory subject matter if a useful, concrete and tangible result is produced

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a customized proposal (i.e., repeatable) that can be used in assisting a customer in purchasing an insurance plan (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-10, 13-14 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lockwood, U.S. Patent Number 4, 567, 359.

(A) As per claim 1, Lockwood teaches a computer assisted method for providing for assisting in providing configuration and sales information for the development of insurance plans for a customer, the method comprising:

collecting customer data within a sales computer system (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

storing the customer data within a database on the sales computer system (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

presenting a description of the insurance plan options available based upon the customer data (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60,

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column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

selecting a preferred set of insurance plans from the available insurance plan options and determining an estimated cost for the preferred set of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

generating a customized proposal for the preferred set of insurance plans, including the customer data, the description of the preferred insurance plans, and the estimated costs for the preferred set of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

(B) As per claims 2-5, Lockwood teaches a method as analyzed and discussed in claim 1 above:

wherein the method further comprises printing the customized proposal (Lockwood; column 7, lines 5-24);

wherein the method further comprises providing insurance company data, insurance application forms, benefit charts data, and provider information data as part of the proposal (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

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wherein the proposal data is provided is electronic form (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

wherein the proposal data is provided is paper form (Lockwood; column 7, lines 5-24).

(C) As per claims 11, 13, Lockwood teaches a computer-readable medium having computer-executable instructions for the method recited in claim 1 above (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

a computer data signal embodied in a carrier wave readable by a computing system and encoding a computer program of instructions for executing a computer process performing the method recited in claim 1 above (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-10, 12, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 as applied to claim 1 above, and further in view of Gamble, et al., U.S. Patent Number 6, 163, 770.

(A) As per claim 6, Lockwood teaches a method as analyzed and discussed in claim 1 above.

Lockwood fails to explicitly disclose

wherein the presenting a description of the insurance plan options comprises determining if an offered plan is available to the customer based upon other plans selected as part of the preferred set of insurance plans as well as the customer data.

However, the above features are well-known in the art, as evidenced by Gamble.

In particular, Gamble teaches wherein the presenting a description of the insurance plan options comprises determining if an offered plan is available to the customer based upon other plans selected as part of the preferred set of insurance plans as well as the customer data (Gamble; Abstract, column 5, line 38 to column 7, line 67, column 9, lines 19-45, column 19, lines 6-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lockwood to include wherein the presenting a description of the insurance plan options comprises determining if an offered plan is available to the customer based upon other plans selected as part of the preferred set of insurance plans as well as the customer data, as taught by Gamble, with the motivations of generating documentation for a first

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insurance policy when a claims cost of the first insurance policy is affected by a concurrent second insurance policy and of efficiently calculating a change in a claims cost of a first insurance policy that is attributable to the presence of a concurrent second insurance policy; and generating printed insurance documentation, including the computed change in the claims cost (Gamble, column 5, line 58 to column 6, line 46).

(B) As per claims 7-8, Lockwood and Gamble teach a method as analyzed and discussed in claims 1 and 6 above

wherein presenting a description of the insurance plan options further comprises:

presenting an indication that a plan may be offered but is not currently available to the customer based upon other plans selected as part of the preferred set of insurance plans as well as the customer data (Gamble, column 19, line 20 to column 21, line 10); and

presenting an indication what conditions are not met for the customer to qualify for the offered but currently not available insurance plan (Gamble, column 19, line 20 to column 21, line 10); and

wherein selecting a preferred set of insurance plans from the available insurance plan options comprises:

selecting one or more sets of possible insurance plans from the available insurance plan options (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

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determining an estimated cost for each of the possible sets of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

generating a customized comparison for the possible set of insurance plans, including the customer data, the description of the preferred insurance plans, and the estimated costs for the preferred set of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

(C) As per claims 9-10, Lockwood and Gamble teach a method as analyzed and discussed in claims 1, 6, 7 and 8 above

wherein the available insurance plan options comprise a plurality of health insurance plans, a plurality of dental insurance plans, a plurality of life insurance plans, and a plurality of disability insurance plans (Gamble; Abstract, column 5, line 38 to column 7, line 67, column 9, lines 19-45, column 19, line 20 to column 21, line 10); and

wherein application data corresponding to the preferred set of insurance plans are transmitted from the sales computer system to a remote server system for processing of the request for insurance (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

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(D) As per claims 12, 14, Lockwood and Gamble teach a computer-readable medium having computer-executable instructions for the method recited in claim 10 above (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

a computer data signal embodied in a carrier wave readable by a computing system and encoding a computer program of instructions for executing a computer process performing the method recited in claim 10 above (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

8. Claim 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gamble, et al., U.S. Patent Number 6, 163, 770 in view of Mori, et al., U.S. Patent Number 6, 070, 148.

(A) Claim 15 differs from claim 1 in that it is an insurance sales and configuration system to assist in providing configuration and sales information for the development of insurance plans to a customer rather than a computer assisted method.

As per claim 15, Gamble teaches an insurance sales and configuration system for providing a system to assist in providing configuration and sales information for the development of insurance plans to a customer, comprising:

a sales computing system having a customer data input module for accepting customer data (Gamble; Abstract, Figure 1, column 5, line 64 to column 6, line 10, column 9, lines 15-45,

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column 14, lines 34-52, column 15, lines 24-67, column 16, lines 1-55), a sales tool module, an insurance plan database, a plan configuration engine module, and a proposal generator module (Gamble; Figure 1, column 14, lines 34-52, column 15, lines 24-67, column 16, lines 1-55); and an information and proposal output module for providing insurance information to the customer (Gamble; Abstract, Figure 1, column 5, line 64 to column 6, line 10, column 9, lines 15-45, column 14, lines 34-52, column 15, lines 24-67, column 16, lines 1-55).

Gamble fails to explicitly disclose
a transportable sales computing system; and
a communication connection to a server computing system for providing application data from the customer and for receiving status and database updates.

However, the above features are well-known in the art, as evidenced by Mori.

In particular, Mori teaches
a transportable sales computing system (Mori; Figure 1, column 2, lines 6-37, column 3, lines 1-35, column 5, line 54 to column 6, line 64); and
a communication connection to a server computing system for providing application data from the customer and for receiving status and database updates (Mori; Figure 1, column 2, lines 6-37, column 5, line 31 to column 6, line 64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Gamble to include a transportable sales computing system; and a communication connection to a server computing system for providing application data from the customer and for receiving status and database updates, as taught by Mori, with the motivations of providing an electronic commerce system in which information concerning a

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suitable commodity or service, such as insurance, can be provided to a user in suitable timing in commercial transactions even in the case where the user makes commercial transactions between a transaction device and a plurality of business connection servers, and a method for providing commodity information, such as insurance information, in the electronic commerce system.

(Mori, column 2, lines 38-52).

(B) As per claim 16, Gamble and Mori teach a system as analyzed and discussed in claim 15 above

wherein the output module is selected from the set of output devices including: a visual display device, a printer, and an electronic file transfer means (Gamble; Abstract, Figure 1, column 5, line 64 to column 6, line 10, column 9, lines 15-45, column 14, lines 34-52, column 15, lines 24-67, column 16, lines 1-55).

9. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gamble, et al., U.S. Patent Number 6, 163, 770 in view of Mori, et al., U.S. Patent Number 6, 070, 148 as applied to claim 15 above, and further in view of Schotz, U.S. Patent Number 4, 837, 693.

(A) As per claim 17, Gamble and Mori teach a system as analyzed and discussed in claim 15 above.

Gamble and Mori fail to explicitly disclose a system wherein customer data includes company data, key contact data, employee census data, affiliate company data, and salesperson notes.

However, the above features are well-known in the art, as evidenced by Schotz.

In particular, Schotz teaches a system wherein customer data includes company data, key contact data, employee census data, affiliate company data, and salesperson notes (Schotz; Figure 3A, Figure 3C, column 5, line 29 to column 6, line 67, column 9, line 45 to column 10, line 5, column 19, lines 35-45, column 28, line 16 to column 29, line 25, column 41, line 1 to column 42, line 35, column 49, lines 3-10, column 51, lines 1-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Gamble and Mori to include wherein customer data includes company data, key contact data, employee census data, affiliate company data, and salesperson notes, as taught by Schotz, with the motivations of providing a new and improved computer system, which facilitates the implementation of an insurance plan, wherein an employee can convert his or her group insurance coverage into an individual term insurance contract, which is a low-cost premium insurance relative to the amount of protection afforded while providing such a system which facilitates an insurance carrier to underwrite such an insurance plan in an effective and cost efficient manner (Schotz, column 2, lines 47-58).

(B) As per claims 18-19, Gamble Mori and Schotz teach a system as analyzed and discussed above

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wherein the insurance plan database includes a plurality of offered insurance plans, a set of cost data for the offered insurance plans, the requirements for the offered insurance plans, and a description of the offered insurance plans (Gamble; Abstract, column 5, line 38 to column 7, line 67, column 9, lines 15-45, column 14, lines 34-52, column 15, lines 24-67, column 16, lines 1-55, column 19, line 6 to column 21, line 10); and

wherein the proposal generator module generates a comparison of two or more offered insurance plans that the customer is qualified to purchase based upon the customer data and the insurance plan database (Schotz; Figure 3A, Figure 3C, column 5, line 29 to column 6, line 67, column 9, line 45 to column 10, line 5, column 19, lines 35-45, column 28, line 16 to column 29, line 25, column 41, line 1 to column 42, line 35, column 51, lines 1-43).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Ryan, et al., United States Patent Number 5,655,085, Hyman, et al., United States Patent Number 6, 092, 047, Luchs et al., United States Patent Number 4, 831, 526, Soumas, et al., United States Patent Number 3, 634, 669, and Schoen, et al., United States Patent 6,235,176 teach the environment of configuring insurance plans for customers.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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Washington D.C. 20231

or faxed to: **(703) 305-7687.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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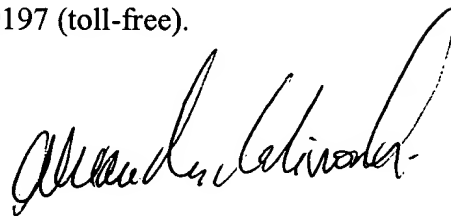
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

December 6, 2004



ALEXANDER KALINOWSKI
PRIMARY EXAMINER